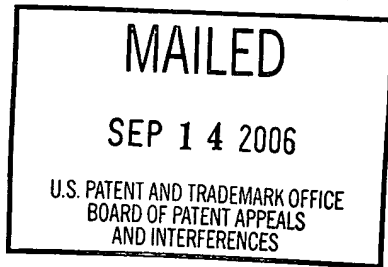


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHIRO TSUCHIDA and TAKATSUGU NAKAZAWA



Appeal No. 2006-2070
Application No. 09/986,586

HEARD: AUGUST 08, 2006

Before FRANKFORT, OWENS and BAHR, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1-6 and 13-24.
Claims 7-12 have been canceled.

THE INVENTION

The appellants claim a computer readable recording medium having a program of a video game recorded therein, a video game apparatus that comprises the computer readable recording medium, and a method for controlling the video game apparatus. Claim 1,

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which claims the computer readable recording medium, is
illustrative:

1. A computer-readable recording medium having a program of a video game recorded therein, at least one predetermined parameter assigned to a player character in said game being changed when the player character defeats an enemy character, wherein

upon being read by a computer, the program of the video game causes the computer to execute;

comparing an amount of damage inflicted on the enemy character by the player character, immediately before the player character defeats the enemy character, with a threshold value previously set for the enemy character;

changing the parameter stored in a storage device according to a first condition, when the enemy is defeated by an amount of damage that is less than the threshold value; and

changing the parameter stored in the storage device according to a second condition that is different from the first condition, when the enemy is defeated by an amount of damage that is at least the threshold value.

THE REFERENCES

Kondo et al. (Kondo)	6,347,993	Feb. 19, 2002 (filed May 12, 2000)
Ohnuma et al. (Ohnuma)	6,375,571	Apr. 23, 2002 (filed Aug. 31, 2000)

Final Fantasy VIII brochure, Square Co. (2000).¹

¹ There are two versions of Final Fantasy VIII of record, one relied upon by the examiner and the other submitted with the reply brief and discussed therein by the appellant. Since these two versions appear to describe the same video game, we have considered both of them.

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-3, 13-15 and 19-21 over Ohnuma in view of Final Fantasy VIII, and claims 4, 5, 16, 17, 22 and 23 over Ohnuma in view of Final Fantasy VIII and Kondo.

OPINION

We reverse the aforementioned rejections. We need to address only the independent claims, i.e., claims 1, 13 and 19. Each of these claims requires 1) comparing an amount of damage inflicted on an enemy character by a player character, immediately before the player character defeats the enemy character, with a threshold value previously set for the enemy character, 2) changing a parameter stored in a storage device according to a first condition when the enemy is defeated by an amount of damage that is less than the threshold value, and 3) changing the parameter stored in the storage device according to a second condition that is different from the first condition when the enemy is defeated by an amount of damage that is at least the threshold value.

Ohnuma discloses an entertainment system that permits a user "to input specific manipulation data via the manual controller (for example, the user can input manipulation data by pressing the control member successively) for changing damage points of a

virtual enemy (monster). Thus, it is possible for the user to actively participate in the battle" (col. 4, lines 2-6). "[T]he user can increase the changing rate of the magic power by pressing the decision button **112d** multiple times so as to increase the damage points of the magic attack. At this time, the levels of the respective graphic effect, sound effect, and vibration effect are also increased based on the changing rate" (col. 12, lines 2-7). A damage calculating means "calculates the damage points of the magic attack based on a predetermined damage points determined by the level of the main character **200**, the selected type or level of the magic spell or magic item, and the changing rate" (col. 15, lines 12-16).

Final Fantasy VIII discloses a video game having a fire cavern full of creatures that are fire-based and, therefore, particularly weak against ice magic. The quicker you can make your way through the Fire Cavern to complete your objective, the better your chance of earning a higher SeeD ranking.

The examiner argues, regarding Ohnuma (answer, page 4):

Upon execution, the computer will compare an amount of damage inflicted on the enemy character by the player character each time the player character attacks, including before and immediately before the player character defeats the enemy (Column 15, lines 50-57). Each enemy character has a threshold value set in the form of hit points. When the amount of damage done by the player character is not equal to the threshold value, the player parameter is changed by a first value (Column 15, lines 51-55). When the

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amount of damage is at least equal to the threshold value and the enemy is defeated, the player parameter is changed by a second value (Column 15, lines 55-59).

The portion of Ohnuma relied upon by the examiner is as follows:

If it is determined that the value of the main character's hit points is not "0", the control goes to Step S27 for determining whether the value of the monster's hit points is "0" or not for each of the monsters 202. If it is determined that the value of the monster's hit points is not "0" for any of the monsters 202, the control goes back to Step S3 and the subsequent steps for performing the next attack turn for the main character 200 or the monsters 202. If it is determined that the value of monster's hit points is "0" for every monster 202, the control goes to Step S28. In Step S28, the process of gaining items, gold and experiences by the main character 200 is performed. Then, process of the parameter changing means 300 is brought to an end. [Col. 15, lines 48-60].

This portion discloses that if the main character and at least one monster have hit points, the next attack takes place, whereas if the main character, but no monster, has hit points, then the main character receives items such as gold and experience points. Thus, even if, as argued by the examiner, each monster's threshold value is zero hit points, there is no disclosure of relating whether a parameter assigned to the main character is changed according to a first or second condition to a determination of whether the amount of damage inflicted on a monster is at least that threshold value.

With respect to Final Fantasy VIII the examiner argues that the SeeD ranking corresponds to the appellants' parameter assigned to the player, and that the SeeD ranking is changed based upon how well the player has done against a threshold value which the examiner apparently considers to be the difference between the actual and estimated times for winning the battle (answer, page 5).

The appellants argue that Final Fantasy VIII compares the time required to reach the end of the cavern and defeat the Boss to the time estimated by the player for completing that entire event and, therefore, does not compare the time taken to defeat the Boss with a threshold value (brief, page 13). The appellants also argue that the reward does not vary based upon the amount of damage measured when the enemy is defeated but, rather, is a standard reward (reply brief, page 5).

The appellants are correct that Final Fantasy VIII bases the reward on a time difference rather than on how much damage the player has inflicted upon the enemy immediately before the player defeats the enemy.

The examiner argues that one of ordinary skill in the art would understand that although Final Fantasy VIII relates the parameter to time, one of ordinary skill in the art would realize that the parameter could be related to other things such as how

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many turns defeating the enemy took, what weapons were used, and how much damage was inflicted upon the enemy (answer, page 6). Relating the parameter to how soundly the enemy was beat would have been obvious to one of ordinary skill in the art, the examiner argues, because, although Ohnuma rewards players equally for defeating the monster, rewarding players who defeat the monster especially well would provide more satisfaction for the players (answer, pages 5-6).

The examiner's argument is not supported by evidence. Thus, the record indicates that the examiner's rationale is based upon impermissible hindsight in view of the appellants' disclosure. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

The examiner argues that the appellants' term "enemy character" encompasses a challenge (answer, page 17). Thus, the examiner argues, the challenge of moving through the cavern quickly can be considered the enemy character (answer, pages 17-18). The examiner does not provide evidence that one of ordinary skill in the art, giving the appellants' claim their broadest reasonable interpretation in view of the specification, would have considered "enemy character" to encompass "challenge".

Regardless, the examiner does not explain, and it is not apparent, how, even if the challenge of moving through the cavern quickly is considered to be the enemy character, the Final Fantasy VIII reward based upon the difference between the estimated and actual times for reaching the end of the cavern and defeating the Boss is related to how much damage the player has inflicted upon the Boss immediately before the Boss is defeated.

The examiner argues that Kondo, which is applied to some of the dependent claims, discloses, at column 21, lines 13-40, awarding a player with a greater number of points the closer the player gets to the threshold value of defeating the character (answer, page 8). That portion of Kondo discloses that if a main character remains within a specified distance of an enemy character for a particular time, the main character is considered to be successful and the level of the game (i.e., the proximity time and the points awarded) is raised by one stage. That portion of Kondo does not disclose changing a parameter assigned to a player character to a first condition or a second condition based upon the amount of damage inflicted on an enemy character immediately before the player character defeats the enemy character. Thus, the relied-upon portion of Kondo does not remedy the deficiency in Ohnuma and Final Fantasy VIII as to the independent claims.

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For the above reasons we conclude that the examiner has not carried the burden of establishing a prima facie case of obviousness of the appellants' claimed invention.


DECISION

The rejections under 35 U.S.C. § 103 of claims 1-3, 13-15 and 19-21 over Ohnuma in view of Final Fantasy VIII, and claims 4, 5, 16, 17, 22 and 23 over Ohnuma in view of Final Fantasy VIII and Kondo, are reversed.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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